

SEP 20 2006

SMITH HOPEN

INTELLECTUAL PROPERTY LAW

Tampa Bay Office · 180 Pine Avenue North · Oldsmar, Florida 34677
Tel: 813-925-8505 · Fax: 813-925-8525 · www.smithhopen.com

Fax

INTELLECTUAL PROPERTY LAW

To:	U.S. Patent & Trademark Office	From:	Michael M. McGaw
Attn:	Examiner: Theodore J. Stigell Art Unit 3763	Client:	1372.30.UTLDV
Fax:	(571) 273-8300	Pages:	15 including coversheet
Phone:		Date:	September 20, 2006
Re:	USPN: 10/708,111	CC:	University of South Florida

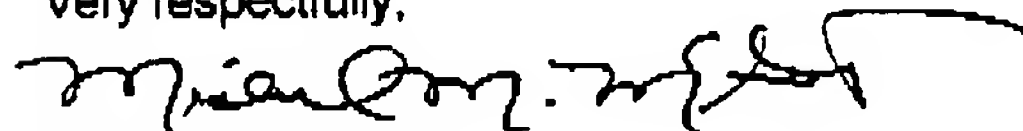
☐ Urgent ☒ For Review ☐ Please Comment ☐ Please Reply ☐ Please Recycle

Dear Examiner Stigell:

Enclose please find the following:

- 1) Transmittal letter with Certificate of Facsimile Transmission under 37 CFR 1.8(a) dated September 20, 2006 (1 page).
- 2) Screen shot showing error message (1 page);
- 3) Notice of Express Abandonment for USPN: 10/709,136 (1 page);
- 4) Notice of Express Abandonment for USPN: 10/708, 140 (1 page);
- 5) Office action for USPN: 10/708,136 (5 pages); and
- 6) Office action for USPN: 10/708,140 (5 pages).

Very respectfully,

Michael M. McGaw
USPTO Reg. No. 53,296

The documentation accompanying this transmission contains information from the Law Office of Smith & Hopen, P.A., which is confidential and/or privileged. The information is intended only for the use of the individual or entity named on this sheet. If you are not the intended recipient, you are hereby notified that any disclosure, copying, distribution, or the taking of any action in reliance upon the contents of this telecopied information is strictly prohibited. If you have received this transmission in error, please notify us by telephone immediately, so that we can arrange for the return of the original documents to us at no cost to you.

SEP 20 2006

Practitioner's Docket No.: 1372.30.UTLDV

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

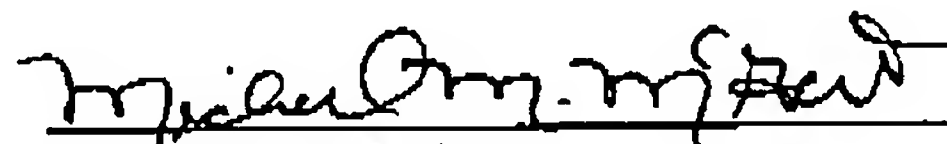
Applicant: Richard Heller)
Serial No.: 10/708,111) Examiner: Theodore J. Stigell
Filed: 02/10/2004) Art Unit: 3762
For: Electroporation and Electrophoresis)
System and Method of Achieving Molecular)
Penetration into Cells In Vivo)

Transmitted to Central Fax at (571) 273-8300
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Examiner Stigell:

We received a server error from EPAVE during the electronic submission of the above referenced utility application indicating that a resource problem occurred. The application was mistakenly assigned three serial numbers as a result of the error. A Notice of Abandonment is being filed for each redundant application contemporaneously with this notice. Attached are copies of the Notice of Abandonment for each. The redundant applications, however, have received office actions subsequent to our discovery of the multiple filings. We attach the office actions received for the redundant applications in keeping with 37 C.F.R. §1.56.

Very respectfully,



Michael M. McGaw
SMITH & HOPEN, P.A.
180 Pine Avenue North
Oldsmar, Florida 34677
(813) 925-8505
Attorneys for Applicants
USPTO Customer No. 21,901


Dated: September 20, 2006
Reg. No. 53,296

pc: University of South Florida

CERTIFICATION OF FACSIMILE TRANSMISSION
(37 C.F.R. 1.8(a))

I HEREBY CERTIFY that this document is being transmitted to the United States Patent and Trademark Office, Central Fax Center 3762, at (571)273-8300 on September 20, 2006.

Date: September 20, 2006


April Turley

Step 5.1 - Actions ; Preview (Acknowledgement receipt)

Actions

- ☒ Add common data elements
- ☒ Attach files to the project
- ☒ Validate the project
- ☒ Submit to USPTO
- ☒ Obtain acknowledgement receipt

New utility

- ☒ Application Data Sheet
 - ☒ Correspondence address
 - ☒ Inventor
 - ☒ Continuity data
 - ☒ Attorney information
 - ☒ Foreign priority claims
 - ☒ Publication information
 - ☒ Publication assignee information
 - ☒ Preview (Application Data Sheet)
- ☒ Declaration
 - ☒ Preview (Declaration)
- ☒ Power of attorney
 - ☒ Preview (Power of attorney)
- ☒ Assignment
 - ☒ Preview (Assignment)
- ☒ Information disclosure statement
 - ☒ Preview (IDS)
- ☒ Fee Transmittal
 - ☒ Fee calculation
 - ☒ Method of payment
 - ☒ Preview (Fee transmittal)

UNITED STATES PATENT AND TRADEMARK OFFICE
ACKNOWLEDGEMENT RECEIPT

Electronic Version 1.1
Stylesheet Version v1.1.1

Title of
Invention

Submission Type:
Application Number:
EFS ID: 200402081410265654062573745949323927
Server Response:

Confirmation Code	Message
ISYS89	Please contact the Patent electronic Business Center at 866-217-9197 or 703-308-2840.
ISYS88	Please do not re-submit this patent application.
ISYS97	If you re-submit, a duplicate submission and therefore double charges may occur.
ESYS99	Server Error. A resource problem occurred.

First Named Applicant:
Attorney Docket Number:
Timestamp: 2004-02-8 EDT
From: US
File Listing:

Doc. Name	File Name	Size (Bytes)
Total files size:		0

Message Digest NA

Done



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,136	02/09/2004	Richard Heller	1372.30.DIV	2135
21901	7590	06/14/2006	EXAMINER	
SMITH HOPEN, PA 180 PINE AVENUE NORTH OLDSMAR, FL 34677			MANUEL, GEORGE C	
			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 06/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/708,136	HELLER ET AL	
	Examiner	Art Unit	
	George Manuel	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

Application/Control Number: 10/708,136
Art Unit: 3762

RECEIVED
CENTRAL FAX CENTER

Page 2

SEP 20 2006

DETAILED ACTION***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver et al '034 in view of Meserol '921.

Weaver et al disclose reservoirs 18 that are filled with molecules that are to be transported and electrodes 16 that are placed in contact with the surface of tissue 22. A pulse generator 12, in communication with the electrodes 16 provides an electrical pulse of a specific shape, voltage, duration and frequency to the electrodes. The shape, duration, frequency and peak voltage of the pulse are controlled by a controller 14. The pulse is gradually cycled to higher voltages until electroporation occurs. At that point, the pulse, shape, duration, frequency and voltage is maintained until a desirable amount of molecular transfer has occurred.

Application/Control Number: 10/708,136
Art Unit: 3762

Page 3


Maeserol teaches pore formation and electrophoretic movement can be most effectively accomplished with the use of exponential pulses.

In view of the teaching of Maeserol, one of ordinary skill in the art would have found it obvious to use an exponentially rising pulse for the pulse generator 12 of the device of Weaver et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Weaver et al '223, Weaver '069, and Lattin et al '953 disclose related electroporation devices capable of delivering a charged molecule into a cell in vivo.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Manuel whose telephone number is (571) 272-4952.


George Manuel
Primary Examiner
Art Unit: 3762

6/9/06

Notice of References Cited	Application/Control No. 10/708,136	Applicant(s)/Patent Under Reexamination HELLER ET AL.	
	Examiner George Manuel	Art Unit 3762	Page 1 of 1

U.S. PATENT DOCUMENTS

★		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
★	A	US-5,911,223	06-1999	Weaver et al.	128/898
★	B	US-5,389,069	02-1995	Weaver, James C.	604/21
★	C	US-5,019,034	05-1991	Weaver et al.	604/20
★	D	US-5,551,953	09-1996	Latin et al.	604/20
★	E	US-5,720,921	02-1998	Meserol, Peter M.	422/44
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

★		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

★		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/708,140	02/09/2004	Richard Heller	1372.30.DIV	2139
21901	7590	06/05/2006	EXAMINER	
SMITH HOPEN, PA 180 PINE AVENUE NORTH OLDSMAR, FL 34677			MANUEL, GEORGE C	
			ART UNIT	PAPER NUMBER
			3762	

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Application/Control Number: 10/708,140

Page 3

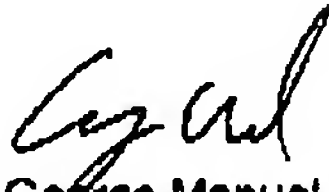
Art Unit: 3762

Kolble because the teaching of Ivory applies to a similar electrophoresis movement of molecules.

Conclusion

The art made of record and not relied upon is considered pertinent to applicant's disclosure. Taakeuchi et al '669 discloses the principle of exponential increase of electrons in the electron emission..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Manuel whose telephone number is (571) 272-4952.


George Manuel
Primary Examiner
Art Unit: 3762

Notice of References Cited	Application/Control No. 10/708,140	Applicant(s)/Patent Under Reexamination HELLER ET AL.	
	Examiner George Manuel	Art Unit 3762	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-2004/0104669	06-2004	Takeuchi et al.	313/497
*	B	US-5,071,536	12-1991	Ivory, Cornelius F.	204/549
*	C	US-5,108,567	04-1992	Kolble, Konrad	204/458
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action (See MPEP § 707 05(a).)
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.